

### **REMARKS**

Applicants have amended claim 45 to overcome the rejections under 35 U.S.C. §§ 101 and 112. Support for the amendments to claim 45 can be found in the specification at, for example, p. 13, lines 14-17. No new matter has been introduced.

#### **Office Action**

In the Office Action, the Examiner:

- (a) rejected claim 45 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement;
- (b) rejected claim 45 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement;
- (c) rejected claim 45 under 35 U.S.C. § 101, as allegedly directed to non-statutory subject matter;
- (d) allowed of claims 24-42, 44, 46, and 47; and
- (e) indicated that claim 45 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. § 112, first paragraph and 35 U.S.C. § 101.

#### **Allowable Subject Matter**

Applicants acknowledge with appreciation the Examiner's indication that claims 24-42, 44, 46, and 47 are allowed, and that claim 45 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 101.

#### **Rejections of Claim 45 under 35 U.S.C. § 112, First Paragraph**

Applicants respectfully traverse the two rejections of claim 45 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement and the enablement requirement. Without conceding to the Office Action's allegations, and in response to the 35 U.S.C. § 101 rejection discussed below, Applicants have amended claim 45 to recite "[a] non-transitory computer readable storage medium."

The Office Action rejects claim 45 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. *See* Office Action, pp. 2-3. Specifically, the Office Action alleges that “there is no support that can be found in the original disclosure” for the “computer readable medium” recited in previously presented claim 45. *Id.* Moreover, despite Applicants’ disclosure of “groups or modules of programs stored on disk and accessible on the network” (emphasis added) at p. 3, line 14 of the specification, which clearly supports the recitation of the “computer readable medium,” the Office Action asserts that the “original disclosure fails to disclose and explicitly define ‘computer readable medium.’” *Id.*, p. 3. This is incorrect.

The written description requirement under 35 U.S.C. § 112, first paragraph, requires that Applicants must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, Applicants were in possession of the invention as now claimed. *See* M.P.E.P. § 2163.02. In order for the disclosure to satisfy the written description requirement, “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*).” *Id.* According to Applicants’ specification, the “groups or modules of programs [are] stored on disk and accessible on the network.” Specification, p. 13, lines 14-15. In addition, the “groups or modules of programs are processing and computation programs that realise the method according to the [disclosed] invention.” *Id.*, p. 13, lines 15-17. Because a “disk” would be known to one of ordinary skill in the art as an exemplary “non-transitory” “computer readable storage medium,” the original disclosure need not disclose or explicitly define the exact term “computer readable [storage] medium,” as required by the Office Action at p. 3. In light of the disclosure of the specification, Applicants have already conveyed with reasonable clarity that Applicants were in possession of the claimed “non-transitory computer readable storage

medium,” as recited in amended claim 45, and therefore, amended claim 45 fully complies with the written description requirement under 35 U.S.C. § 112, first paragraph.

The Office Action also rejects claim 45 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. *See* Office Action, p. 3. Specifically, the Office Action alleges that “there is no support that can be found in the specification for a computer readable medium” recited in claim 45. *Id.* In addition, the Office Action alleges that “since a computer readable medium can both encompass transient and non transitory media, the computer readable medium is directed towards non statutory subject matter.” *Id.* Furthermore, the Office Action alleges that “since ‘computer readable medium’ was not explicitly defined, it is unclear to one of ordinary skill in the art as to what the ‘computer readable medium’ is referred to in the specification, whether ‘the computer readable medium’ is stored on disk or ‘the computer readable medium’ is accessible on the network and to whether ‘the computer readable medium’ is the disk or if the memory is the disk.” *Id.*

Applicants respectfully traverse this rejection for the following reasons. First, as stated above, the recitation of “non-transitory computer readable storage medium” in amended claim 45 is fully supported at least by the disclosure of a “disk” in the specification. The term “non-transitory computer readable storage medium” is well known to one of ordinary skill in the art, such that it could be used to claim the “disk” disclosed in the specification. Therefore, even though the exact term “non-transitory computer readable storage medium” is not explicitly defined in the specification (*see* M.P.E.P. § 2163.02), one of ordinary skill in the art would appreciate, from viewing the specification, that the term “non-transitory computer readable storage medium” covers computer media such as disks.

Second, the Office Action appears to allege that claim 45 fails to comply with the enablement requirement solely because the term “‘computer readable medium’ was not explicitly

defined [in the specification].” Office Action, p. 3. This is incorrect. In order to determine whether a claim meets the enablement requirement, the standard is “whether one reasonably skilled in the art could make or use the [claimed] invention from the disclosures in the patent [application] coupled with information known in the art without undue experimentation.” M.P.E.P. § 2164.01. In this case, the specification discloses a “disk,” which is an exemplary type of “non-transitory computer readable storage medium,” as would have been well known to one of ordinary skill in the art. Therefore, considering the teachings in the specification, combined with the knowledge of one of ordinary skill in the art, one of ordinary skill in the art would have been able to make and use a “non transitory computer readable storage medium,” as recited in amended claim 45, without undue experimentation. Thus, claim 45 fully complies with the enablement requirement under 35 U.S.C. § 112, first paragraph. Accordingly, Applicants request reconsideration and withdrawal of the rejection.

**Regarding the Rejection of Claim 45 under 35 U.S.C. § 101**

The Office Action rejects claim 45 under 35 U.S.C. § 101, alleging that “[because] a computer readable medium can both encompass transitory (non statutory subject matter such as signals, waveform, etc.) and non transitory media, the computer readable medium [recited in claim 45] is directed towards non statutory subject matter.” Office Action, p. 4. The Office Action suggests amending claim 45 to recite “a non transitory computer readable medium” to only encompass statutory subject matter. *Id.* In response, Applicants have amended claim 45 to recite “[a] non-transitory computer readable storage medium,” which is consistent with the Office Action’s suggestion. Accordingly, Applicants request reconsideration and withdrawal of the rejection.

**Conclusion**

Applicants request reconsideration of the application and withdrawal of the rejections. Pending claims 24-42 and 44-47 are in condition for allowance, and Applicants request a favorable action.

The Office Action contains a number of statements reflecting characterizations of the cited art and the claims. Regardless of whether any such statements are identified herein, Applicants decline to automatically subscribe to any such statements or characterizations.

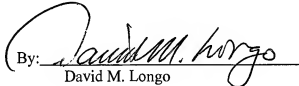
If there are any remaining issues or misunderstandings, Applicants invite the Examiner to telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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